

REMARKS

Claims 1-20 and new claim 21 are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1 and 17 have been amended in a manner discussed with the Examiner in order to clarify the invention. Claim 21 has been canceled accordingly. In addition, new claim 22 has been added to recite an additional embodiment of the invention recited in claim 11 and includes subject matter that is fully supported by the grandparent application no. 09/721,749, filed November 27, 2000.

As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

THE INTERVIEW

Applicants appreciate the courtesies extended by the Examiner during the interview held on July 19, 2005. The claim amendments and arguments herein are substantially in accord with the discussion during the interview. In addition, Applicants submit an Information Disclosure Statement to formally disclose the existence of litigation regarding the parent patent (6,818,705). As discussed during the interview, included in the opposing counsel's allegations regarding the '705 patent is an invalidity argument based on references considered by the Examiner both in the '705 patent and the present application.

THE REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-10 and 17-20 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,315,684 to Binette *et al.* or U.S. Patent No. 6,419,594 to Nesbitt *et al.* in view of U.S. Patent No. 5,697,856 to Moriyama *et al.* for the reasons stated on page 2 of the Office Action. Neither the combination of Binette and Moriyama nor the combination of Nesbitt and Moriyama render obvious the present invention for at least the reasons that follow.

As recognized the Examiner, the primary references Binette and Nesbitt lack the inclusion of an organosulfur cis-to-trans catalyst. Office Action at Page 2. As a result, the Examiner has

relied upon Moriyama '856 for its disclosure of catalyst. The Moriyama '856 patent does not, however, disclose or suggest a metal organosulfur compound for use as a cis-to-trans catalyst, as presently recited in claim 1 of the instant application, but rather limits the suitable catalysts to sulfides. Col. 2, lines 47-54. As such, the combination of Binette and Moriyama '856 or Nesbitt and Moriyama '856 does not render obvious the invention recited in independent claim 1.

Furthermore, the suggested combinations do not render obvious the invention recited in claim 17 and those claims depending therefrom. For example, the Moriyama '856 patent teaches away from the claimed amount of trans-isomer in independent claim 17. In fact, the Moriyama '856 patent teaches that the trans structure after vulcanization *must* be within the range of 10 percent to 30 percent and further explains that "when the amount of trans structure *exceeds* 30 percent, the core is too soft and the resilience performances are deteriorated." Col. 3, lines 27-33 (emphasis added). As such, the Moriyama '856 patent does not disclose or suggest a reaction product having a trans-polybutadiene isomer content of greater than about 32 percent. Thus, one of ordinary skill in the art would have lacked any motivation to make a core with the trans-isomer content recited in claim 17 (and those depending therefrom) without the present invention to use as a template.¹

In light of the explanation above, Applicants respectfully submit that none of the cited references disclose or suggest the present invention. Consequently, Applicants respectfully request reconsideration and withdrawal of the rejections based thereon.

THE DOUBLE PATENTING REJECTION

The Examiner rejected claims 1-21 under the judicially created doctrine of obviousness-type double patenting as obvious over claims 1-50 of the grandparent patent no. 6,486,261 to Wu *et al.*, claims 1-22 of parent patent no. 6,818,705 to Wu *et al.*, and claims 1-19 of U.S. Patent No. 6,818,724 to Wu *et al.* In addition, claims 1-21 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting based on co-pending U.S. Patent Application Nos. 10/694,746, 10/694,800, 10/694,798, and 10/694,754. Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) in order to overcome the double patenting rejections based on the parent and grandparent patents and co-pending patent applications. As such, Applicants respectfully request that the double patenting rejection be withdrawn.

¹ It appears that the Examiner also recognizes the deficiencies of the cited reference with respect to the presently recited amount of trans-isomer after conversion based on the absence of a § 103 rejection of previously recited claim 21.

CHANGE IN ATTORNEY DOCKET NUMBER

A Request for Change in Attorney Docket Number is submitted herewith to change the docket number from 20002.0263D to 20002.0366.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response one month to and including August 15, 2005. A Fee Sheet Transmittal is submitted to pay for this extension, the Terminal Disclaimer, and the Information Disclosure Statement. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin LLP Deposit Account No. 195127, Order No. 20002.0366.

Respectfully submitted,
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